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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,561	10/24/2001	James P. Donelan	112692-006	5058

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EXAMINER

FERNSTROM, KURT

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/003,561

Applicant(s)

DONELAN, JAMES P.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cov r she t with th correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: .

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "having dry erase characteristics" in claims 1, 9, 14, 18 and 19 is overly broad, as it does not specifically which characteristics are intended to be encompassed by the claim language. Also, claim 13 is indefinite because a sheet was never claimed as part of claim 9; thus, "the sheet" in claim 13 lacks antecedent basis. Claim 17 is also indefinite because "may receive indicia" is not a positive limitation; thus, claim 17 does not provide any further limitation to the scope of the invention..

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1, 5, 9 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Winfrey. Winfrey discloses in column 5, lines 4-56 of the specification a device comprising a body formed from plates 12 and 14, which in one embodiment is a folded sheet of transparent substrate (see lines 20-23). This fold represents a bent end capable of securing a sheet of paper to the body. The body further comprises an overlay sheet 16 having dry erase characteristics. With respect to claim 13, the sheet inserted into the device has indicia thereon.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 6-8, 10, 14, 15, 17 and 18 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Winfrey in view of Weinthrop. Winfrey discloses all of the limitations of claim 3, 4, 6-8 and 10 with the exception of the second bent end and the semi-rigidity of the body. Folders for retaining paper comprising semi-rigid material are extremely well known. Weinthrop discloses in column 1, lines 1-10 of the specification a folder comprising semi-rigid material. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Winfrey by providing a semi-rigid material for the purpose of making the device lighter and easier to manipulate, particularly since semi-rigid transparent material is well known, as shown for

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example by overlay sheet 16 of Winfrey. Weinthrop further discloses in Figure 1 that the body 2 comprises bent sections 12, 7 and 10, which are folded to allow the device to retain sheets of paper. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Winfrey by providing a plurality of bent sections to the body for the purpose of more securely retaining the sheet of paper within the device. The bent ends contact various surfaces and edges of the sheet. With respect to claims 14 and 15, Weinthrop discloses in column 1, lines 62-67 that the bending of the sections forms a pocket. With respect to claim 18, the pocket formed by overlay 16 has dry erase characteristics.

7. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winfrey in view of Weinthrop, and further in view of Ko. Winfrey as viewed in combination with Weinthrop discloses all of the limitations of claims 2 and 12 with the exception of the device being flat when shipped. It is known to ship folding items in an unfolded state. Ko discloses in column 1, lines 53-60 of the specification one example of folding binders which are shipped in a flat state. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Winfrey as viewed in combination with Weinthrop by providing the device in a flat state when shipping for the purpose of making the device less thick, and thus easier to ship in larger numbers.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winfrey in view of Mogelonsky. Winfrey discloses all of the limitations of claim 11 with the exception of the use of adhesive to attach the pocket. Adhesive is a well known means of attaching elements of a folder.

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Mogelonsky discloses in column 7, lines 40-43 of the specification one example of a folder which comprises adhesive 29, which is used to attach members 26 and 14 to form a pocket 30. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Winfrey by providing adhesive for the purpose of more securely assembling the folder to retain a sheet of paper.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winfrey in view of Weinthrop, and further in view of Mogelonsky. Winfrey as viewed in combination with Weinthrop discloses all of the limitations of claim 16 with the exception of the use of adhesive to attach the pocket. Adhesive is a well known means of attaching elements of a folder. Mogelonsky discloses in column 7, lines 40-43 of the specification one example of a folder which comprises adhesive 29, which is used to attach members 26 and 14 to form a pocket 30. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Winfrey as viewed in combination with Weinthrop by providing adhesive for the purpose of more securely assembling the folder to retain a sheet of paper.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winfrey in view of Weinthrop, and further in view of Winfrey as viewed in combination with Weinthrop discloses all of the limitations of claim 16 with the exception of the use of adhesive to attach the pocket. Adhesive is a well known means of attaching elements of a folder. Mogelonsky discloses in column 7, lines 40-43 of the specification one example of a folder which comprises adhesive 29, which is used to attach members 26 and 14 to form a pocket 30. It would have been obvious to

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one of ordinary skill in the relevant art to modify the device disclosed by Winfrey as viewed in combination with Weinthrop by providing adhesive for the purpose of more securely assembling the folder to retain a sheet of paper.

11. Claims 19 and 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winfrey as viewed with Weinthrop, and further in view of Schwartz. Winfrey as viewed in combination with Weinthrop discloses all of the limitations of claims 19 and 20 with the exception of the open back. Schwartz discloses in Figures 4 and 4a a folder comprising one open side, which could be the back depending on how the device is positioned. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Winfrey as viewed in combination with Weinthrop by providing a device with an open back for the purpose of providing easier access to a sheet of paper retained therein.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Steffen, Hure and Lee disclose various folding devices.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

November 14, 2002


Kurt Fernstrom